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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91212768
Party	Defendant Disidual Clothing, LLC
Correspondence Address	CRAIG A. BEAKER MARSHALL GERSTEIN & BORUN LLP 233 SOUTH WACKER DRIVE6300 WILLIS TOWER CHICAGO, IL 60606-6357 UNITED STATES gchinlund@marshallip.com, cbeaker@marshallip.com, kking@marshallip.com
Submission	Opposition/Response to Motion
Filer's Name	Craig A. Beaker
Filer's e-mail	gchinlund@marshallip.com, cbeaker@marshallip.com, kking@marshallip.com
Signature	/Craig A. Beaker/
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

INTS It Is Not The Same, GmbH,

Opposer,

v.

Disidual Clothing, LLC,

Applicant.

Serial No. 85/836,544

Opposition No. 91212768

Mark: DISIDUAL

**DISIDUAL CLOTHING’S RESPONSE TO OPPOSER’S  
MOTON FOR LEAVE TO AMEND NOTICE OF OPPOSITION**

Applicant Disidual Clothing, LLC (“Disidual”) hereby responds to Opposer INTS It Is Not The Same, GmbH’s (“Opposer”) Motion for Leave to Amend Notice of Opposition filed on March 1, 2016 (hereinafter “Motion to Amend”).

**I. INTRODUCTION**

Opposer seeks to add three additional claims against Disidual’s trademark application, namely, (1) that Disidual has abandoned its mark, (2) that Disidual committed an alleged fraud on the U.S. Patent and Trademark Office when it filed its DISIDUAL application, and (3) that the application is *void ab initio*. Opposer filed its Motion to Amend almost seven months after learning of the basis for its claims and two days before the testimony period was scheduled to begin. Moreover, Opposer’s claims introduce several new issues to the proceeding after discovery closed, after the Trademark Trial and Appeal Board (“Board”) ruled on the parties’ respective motions for summary judgment, and after service of Opposer’s pretrial disclosures. Opposer provides no valid justification for its undue delay in filing its Motion to Amend, especially since it knew of the basis for its purported claims in August 2015. Additionally, the

introduction of these new claims at this late stage in the proceeding would be prejudicial to Disidual. The Board should therefore deny Opposer's Motion to Amend.

## **II. ARGUMENT**

### **A. Legal standard**

Pursuant to Rule 15(a) of the Federal Rules of Civil Procedure, the Board liberally grants leave to amend pleadings. However, motions to amend will not be granted when the proposed amendment would be prejudicial to the rights of the respondent. Trademark Trial and Appeal Board Manual of Procedure ("TBMP") § 507.02. One major factor in determining whether the respondent would suffer prejudice is the timing of the motion for leave to amend. *Int'l Finance Corp. v. Bravo Co.*, 64 U.S.P.Q.2d 1597, 2002 WL 1258278 (TTAB 2002). "A long and unexplained delay in filing a motion to amend a pleading (when there is no question of newly discovered evidence) may render the amendment untimely." TBMP § 507.02(a). Moreover, prejudice may be found where the added claims would result in increased time, effort, and money that the respondent would be required to expend to defend against an additional claim (or claims). See *ChaCha Search, Inc. v. Grape Tech. Group, Inc.*, 105 U.S.P.Q.2d 1298, 2012 WL 6929402, \*4 (TTAB 2012); *Media Online Inc. v. El Clasificado Inc.*, 88 U.S.P.Q.2d 1285, 2008 WL 4419361, \*3 (TTAB 2008)

### **B. Opposer's motion should be denied because it is untimely and would result in undue prejudice to Applicant**

Despite the fact that Opposer knew of the basis for its new claims in August 2015, Opposer waited almost seven months to file its Motion to Amend and just two days before its testimony period was scheduled to begin. Based on Opposer's long and unexplained delay, the Board should refuse Opposer's motion as untimely and prejudicial to Applicant.

First, Opposer's motion should be denied on its face as untimely. The below chart sets forth the relevant dates for purposes of ruling on Opposer's Motion to Amend. Of note, Opposer learned of the basis for its claims on August 11, 2015. Opposer does not contest this point. *See* Motion to Amend, p. 3. Opposer waited to file its Motion to Amend until March 1, 2016, which was after Opposer filed its Motion for Summary Judgment and after it filed its pretrial disclosures.

<b>Schedule</b>	<b>Date</b>
Relevant discovery disclosed	August 11, 2015
Discovery period closed	September 17, 2015
Opposer's Motion for Summary Judgment filed	November 11, 2015
Opposer's pretrial disclosures served	February 18, 2016
Opposer's Motion to Amend filed	March 1, 2016
Opposer's testimony period scheduled to open	March 3, 2016

As justification for its delay, Opposer contends that it waited to file its Motion to Amend until after the Board ruled on its Motion for Summary Judgment “[i]n an effort to mitigate the amount of time and resources the parties and the Board would need to dedicate to this proceeding.” Motion to Amend, p. 3. Opposer's justification simply does not hold weight. Had Opposer timely filed its Motion to Amend before or at the same time as it filed its Motion for Summary Judgment, the Board could have considered all of the alleged claims in this proceeding. The Board previously stated, “[I]t is incumbent upon [the moving party] to identify all claims promptly to provide [the respondent] with proper notice. Otherwise, allowing piecemeal prosecution of this case would reward [the moving party] for its apparent haphazardness and would unfairly prejudice [the respondent]...” *ChaCha Search, Inc.*, 105 U.S.P.Q.2d 1298, 2012 WL 6929402, at \*4.

Opposer also contends that it filed its Motion to Amend promptly after learning of the grounds for the three new claims. Motion to Amend, p. 3. Seven months does not constitute prompt filing. In fact, the Board previously denied motions to amend where the moving party waited three and a half months and seven months. *See The Black & Decker Corp. v. Emerson Elec. Co.*, 84 U.S.P.Q.2d 1482, 2007 WL 894416 (TTAB 2007) (three and a half month delay); *Media Online Inc.*, 88 U.S.P.Q.2d 1285, 2008 WL 4419361 (seven month delay). Based on these decisions, and Opposer's failure to provide a valid justification for its delay (e.g., newly-discovered evidence), Disidual submits that Opposer's Motion to Amend is untimely.

Second, Disidual would suffer undue prejudice if Opposer is allowed to amend its Notice of Opposition and add three new claims on the eve of trial. The Board has previously held that a respondent would suffer undue prejudice where the moving party had ample time to file a motion for leave to amend its pleading at an earlier stage in the proceeding and failed to do so. For example, in *ChaCha Search, Inc. v. Grape Technology Group, Inc.*, the moving party sought to add a new claim after it served its pretrial disclosures and after a motion for summary judgment had already been filed. 105 U.S.P.Q.2d 1298, 2012 WL 6929402. The Board concluded that the respondent would suffer undue prejudice because the new claim would increase the time, effort, and money that respondent would be required to expend to defend against the new claim. *Id.* at \*4; *see also Media Online Inc.*, 88 U.S.P.Q.2d 1285, 2008 WL 4419361, at \*3 ("allowing piecemeal prosecution of this case would unfairly prejudice respondent by increasing the time, effort, and money that response would be required to expend..."); *Int'l Finance Corp. v. Bravo Co.*, 64 U.S.P.Q.2d 1597, 2002 WL 1258278 ("[T]he Board finds that applicant would suffer prejudice if opposer is permitted to add a dilution claim long after the close of discovery.").

Here, Opposer waited nearly seven months to file its Motion to Amend and it provides no valid justification for its delay. The testimony period is now scheduled to begin shortly and Disidual has made decisions regarding the prosecution of its case based on the active pleadings. If the Board allows Opposer to add three new claims, none of which are related to Opposer's likelihood of confusion claim, Disidual will be required to expend significant time, effort, and money to defend its application against these new claims. Opposer's unjustified delay will cause Disidual to suffer undue prejudice, and Opposer would be rewarded for what was either a tactical decision to withhold its new claims until the eve of trial or, at best, its apparent haphazardness in delaying the assertion of these claims when Opposer could have done so in August 2015 while the discovery period was still open. Consequently, Opposer's Motion to Amend should be denied.

### **III. CONCLUSION**

Opposer's Motion to Amend would result in prejudice to Disidual because it would allow Opposer to add three new claims on the eve of trial. Opposer waited almost seven months after learning of the basis for its claims and after the close of discovery. Opposer's undue delay should not be rewarded by granting Opposer's Motion to Amend. Accordingly, Disidual respectfully requests that the Board deny Opposer's Motion to Amend in its entirety.

Respectfully submitted,

Dated: March 21, 2016

/Craig A. Beaker/  
Gregory J. Chinlund  
Craig A. Beaker  
MARSHALL, GERSTEIN & BORUN LLP  
6300 Willis Tower  
233 South Wacker Drive  
Chicago, Illinois 60606  
(312) 474-6300

Attorneys for  
DISIDUAL CLOTHING, LLC

### **CERTIFICATE OF SERVICE**

The undersigned affirms that DISIDUAL CLOTHING'S RESPONSE TO OPPOSER'S MOTON FOR LEAVE TO AMEND NOTICE OF OPPOSITION was served by first class mail, postage prepaid, on the date set forth below upon the following:

John S. Egbert  
Egbert Law Offices, PLLC  
1314 Texas, 21st Floor  
Houston, TX 77002

Dated: March 21, 2016

/Craig A. Beaker/  
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Craig A. Beaker